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Paper No. 5

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In re Application of
Smith, et al.
Application No.: 09/902,811
Filed: July 10, 2001
Attorney Docket No.: MS1-862US
For: APPLICATION PROGRAM INTERFACE
FOR NETWORK SOFTWARE PLATFORM

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MAY 19 2003

OFFICE OF PETITIONS

**DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)**

This is a decision on the petition under 37 CFR 1.47(a), filed March 25, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 10, 2001 without an executed oath or declaration. Accordingly, on January 25, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring *inter alia* an executed oath or declaration, filing fees, and a surcharge for their late filing.¹

In response, on March 25, 2002, a declaration executed by 50 of 51 joint inventors, the surcharge, application filing fees, the petition fee, and the instant petition were filed. The petition states that non-signing joint inventor David Bau received a copy of the application, a declaration, and an assignment for the above-identified application, but did not respond to the request that he sign the declaration for the patent application.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. David Driver's citizenship has been omitted from the

¹ The sequence listing requirements will not be discussed in this decision.

declaration. The citizenship of each inventor must be included on the oath or declaration. As listing the citizenship for each inventor is a statutory requirement under 35 USC 115, it cannot be waived.

In addition, the declaration contains noninitialed, nondated alteration to Joseph Roxe's information. 37 CFR 1.52(c) states that "[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of the accompanying oath or declaration pursuant to 1.63...." This includes the oath or declaration. The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of Mr. Bau is REQUIRED. See MPEP 409.03(a).

Fortunately, the deficiencies or inaccuracies relate to signing inventors. Thus, pursuant to 37 CFR 1.67(a)(2), Mr. Driver and Mr. Roxe can correct their respective information on a supplemental declaration identifying the entire inventive entity but signed only by them.

Further correspondence with respect to this matter should be addressed as follows:

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